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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/025,205   | 12/19/2001  | Robert L. Clarke     | KCX-459 (16596)     | 4932             |
| 22827  | 7590        | 10/15/2004           | EXAMINER            |                  |
| <b>DORITY &amp; MANNING, P.A.</b><br>POST OFFICE BOX 1449<br>GREENVILLE, SC 29602-1449 |             |                      |                     | FORTUNA, JOSE A  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 1731   |             |                      |                     |                  |

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                             |                  |
|------------------------------|-----------------------------|------------------|
| <b>Office Action Summary</b> | Application No.             | Applicant(s)     |
|                              | 10/025,205                  | CLARKE ET AL.    |
|                              | Examiner<br>José A. Fortuna | Art Unit<br>1731 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 02 August 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 and 16-23 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 and 15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 December 2001 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9 and 15 are rejected under 35 USC §103(a). This rejection is set forth in the prior Office action mailed on April 26, 2004.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Claims 1-3, 9 and 15 are rejected under 35 USC §102(b). This rejection is set forth in the prior Office action mailed on April 26, 2004.

### ***Response to Arguments***

3. Applicant's arguments filed on August 02, 2004 have been fully considered but they are not persuasive.

Regarding the 103(b) rejection of claims 1-9 and 15, applicants argue that vacuum system of the secondary references cannot be incorporated into the structure of the primary reference for different reasons, see applicants' remarks, and therefore one of ordinary skill in the art would not find the combination obvious. This is unconvincing for the following reasons:

- a) The secondary references were cited only to evidence the use of vacuum rolls as transferring mechanisms in the papermaking or web making operations. It is examiner contention that one of ordinary skill in the art would have reasonable

expectation of success if the web of the primary reference, Linkletter, were transferred using a vacuum pick-up roll instead of the air transferring system.

Note that it has been held that “[W]here two equivalents are interchangeable for their desired function, substitution would have been obvious and thus, express suggestion of desirability of the substitution of one for the other is unnecessary.”

*In re Fout* 675 F. 2d 297, 213 USPQ 532 (CCPA 1982); *In re Siebentritt*, 372 F.2d 566, 152 USPQ 618 (CCPA 1967).

b) The question in a rejection for obviousness on a combination of reference is what the secondary reference would teach one of ordinary skill in the art and not whether its structure could be bodily substituted in the basic reference structure.

*In re Richman*, 165 USPQ 509 (CCPA 1970); *In re Bozek*, 163 USPQ 545 (CCPA 1969); *In re Van Beckum*, 169 USPQ 47 (CCPA 1971); *In re Henley*, 112 USPQ 56 (CCPA 1956); *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir 1983).

Regarding the 102(b) rejection of claims 1-3, 9 and 15, applicants argue that the system of the primary reference does not produce a suction to attract the web across the subsequently formed draw D. This is considered unconvincing, because the claims do not require that the web be supported by the vacuum device to a determined or predetermined distance, only that it attracts the web for transferring. Moreover, the figures, more specifically figures 1 and 2, of the present application show that the web is supported by the first fabric after the suction pick-up roll, which is the same system disclosed/shown by the reference. Note that these are apparatus/device claims and it has been held that a recitation with respect to the manner in which

a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

*Conclusion*

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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Jose A. Fortuna  
Primary Examiner  
Art Unit 1731

JAF